

## REMARKS

The present amendment is submitted in conjunction with a Request for Continued Examination and in response to the final Office Action dated January 28, 2009, which set a three-month period for response, making a response due by April 28, 2009.

Claims 1-12 and 14-20 are pending in this application.

In the final Office Action, claim 1 was objected to for an informality. Claims 1, 2, 6, 7, 11 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2397704 A to Mather et al in view of U.S. Patent No. 6,066,938 to Hyodo. Claims 1, 3, 4, 5, and 7 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,571,949 to Burrus, IV et al in view of Hyodo et al.

In the present amendment, claim 1 has been amended to address the objection and to more clearly define the present invention over the cited reference combination. Specifically, amended claim 1 now defines that the *“second receiving area is embodied as a stand and comprises charging contacts to transmit charging energy”*.

As analyzed in detail in the last response to the previous Office Action, neither Mather, Burrus et al, nor Hyodo et al discloses or teaches a device with a power tool case with *a first receiving area and a second receiving area*, wherein the power tool is *stored* in a transport position *in the first receiving area* and wherein the power tool is arranged in *a second receiving area during a charging*

*procedure* in a standing position as defined in claim 1. Due to the structure according to claim 1, it can be easily detected by an operator or even by any bypassing person, whether the power tool (16) is being charged (standing position) or is stored for the purpose of transportation (lying position). If the power tool (16) is located in the first receiving area (12), the tool (16) is stored for transportation. However, if the power tool (16) is arranged in the second receiving area (26), indicated by the standing position of the power tool (16), the power tool (16) and a charger (14) are in the recharging mode. Therefore, a construction or arrangement can be provided which is very operator friendly and which can indicate its present condition with less effort.

Mather discloses providing a case (1) with one storage area for a power tool in the event of transportation and storage, respectively (see Mather, Fig. 1 and page 1, lines 1 to 3).

The Burrus reference discloses arranging a power tool (104) in a lying position in a compartment (101), which is located in a toolbox (100) electrically connected to an automotive electrical system when the vehicle is running (see Burrus, Figs. 1, 2 and 4, column 2, lines 25 to 27, and lines 40 to 56).

Hyodo et al teaches arranging an impact screwdriver (1) in an upright position in a charger (20) (see Hyodo et al, Fig. 10, and the abstract). Thus, each of the cited references shows only one receiving area. Whereas Hyodo et al. might show that the power tool can be stood in the area during charging, this does not support modification of either of the primary references to add a second receiving area for this purpose.

Instead Hyodo et al would only lead the practitioner to modify Mather or Burrus et al to provide one receiving area in which the tool could be charged in a standing position rather than stored in a lying position, since likewise, neither Mather nor Burrus et al. proposes two receiving areas.

In Burrus et al especially, no suggestion is provided which would have led someone skilled in the art to arrange the power tool (104) in a standing position during charging or to provide a second receiving area for charging the power tool (104) in a standing position. Since the Burrus et al reference specifically discloses arranging the power tool (104) in a lying position during charging it could not be seen why a person skilled in the art should change this arrangement.

Indeed, such a modification actually contradicts the Burrus disclosure, because the charging of the power tool (104) is performed during the transport and thus when the vehicle is moving. A standing arrangement of the power tool (104) would be very unstable and would lead to an unreliable transport and charging of the power tool (104). This would not only affect the charging result but also the work of the people who operate with the insufficiently charged power tool (104).

Moreover, this unstable transport situation could also result in a damage of the power tool (104) when falling out of the charger during transport. Thus, someone skilled in the art would not consider arranging the power tool (104) in a standing position during charging.

The Applicant therefore respectfully submits that a prima facie case of obviousness is not established by the cited reference combination, since the prior art does not suggest the desirability of the claimed invention (MPEP section 2143.01). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992).

The application in its amended state is believed to be in condition for allowance. Action to this end is courteously solicited. However, should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael J. Striker", with a long horizontal flourish extending to the right.

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